

Our Docket No.: 042390.P4823C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Watts et al.

Examiner: Not yet assigned

Application No.: Not yet assigned

Art Group: Not yet assigned

Filed: Concurrently Herewith

For: Method and Apparatus for Providing
Subsidiary Data Synchronous to
Primary Content Data

PRELIMINARY REMARK

Box Patent Application
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully request the Examiner to consider the following remark.

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that I am causing the above-referenced correspondence to be deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and that this paper or fee has been addressed to the Assistant Commissioner for Patents, Washington, D. C. 20231

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Remark

Applicant respectfully submits that Claims 1-37 are allowable over the prior art. Claim 1 recites “determining the identity of the primary content data currently displayed.” With respect to U.S. Patent No.5,774,664 of Hidary et al., cited in the prosecution of parent application, Hidary teaches a system which receives URL’s and retrieves the related Web pages (Abstract, lines 4-7). In one version of Hidary, the URL’s are broadcast in the VBI of a video program (col. 4, lines 44-47). In another version, broadcasters pre-program the URL’s to be transmitted to a user at a predetermined time (col. 3, lines 43-47). Neither version teaches or suggests determining the identity of the primary content data currently displayed.

In the first version of Hidary, the URL’s are transmitted at the same time as the primary program and the web pages are retrieved right after the URL’s are received.. The URL’s can also be time-stamped, to be used later. In this case, there is nothing in Hidary to prevent a later time-stamped URL for one channel from appearing on the user’s web browser after the channel has been changed. Since the subsidiary data is transmitted along with the primary content data, there is no motivation in this version of Hidary to determine “ the identity of the primary content data currently displayed”.

The second version of Hidary also does not teach, suggest, or motivate “determining the identity of the primary content data currently displayed.” In this version of Hidari, the broadcasters pre-schedule Internet addresses or URL’s “for transmission to users at particular times of day” (col. 3, lines 45-47). This version only teaches or suggests that the URL’s are automatically transmitted in advance at a pre-determined

time. Except for a time stamp, there is in Hidary about how to determine whether a webpage should be retrieved. Thus, the URL's are transmitted to the user regardless of the identity of the primary content data currently displayed.

Claim 1 further recites "determining whether subsidiary data supplementing the primary content data exists by accessing a storage database using the primary content data identity." The URL's in Hidary are either transmitted along with the primary content data or are broadcast separate from the primary content data. Thus, there is nothing in Hidary to teach, suggest, or motivate "determining whether subsidiary data ... exists." Furthermore, since Hidary does not teach or suggest determining the identity of the primary content data, it also cannot teach or suggest "accessing a storage database using the primary content data identity."

Claims 16, 27, and 35 are independent claims which contain limitations similar to those of claim 1 and are therefore believed to be allowable for at least the reasons discussed above. The remaining claims depend directly or indirectly from one of claims 1, 16, or 27 and are believed to be allowable for at least the reasons discussed above as well as for the limitations specifically set forth in each claim.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 7/20/11

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